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APPLICATION NO.	FI	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/616,571	- (07/10/2003	Masayoshi Usui	USUI-13K 1339	
1218	7590	12/29/2004		EXAMINER	
CASELLA			NICHOLSON, ERIC K		
274 MADISON AVENUE NEW YORK, NY 10016				ART UNIT PAPER NUMBER	
	•			3679	······································

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	A	A and the second of
	Application No.	Applicant(s)
Office Action Summary	10/616,571	USUI ET AL.
Office Action Summary	Examiner	Art Unit
The MAILING DATE of this communication app	Eric K Nicholson	3679
Period for Reply	ears on the cover sheet with the c	orrespondence address
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period who is a reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be tin within the statutory minimum of thirty (30) day rill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).
Status		
Responsive to communication(s) filed on This action is FINAL . 2b)⊠ This Since this application is in condition for allowar closed in accordance with the practice under E	action is non-final. nce except for formal matters, pro	
Disposition of Claims		
4) ☐ Claim(s) 1-4 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 1-4 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and/or		
Application Papers		
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) access Applicant may not request that any objection to the Replacement drawing sheet(s) including the correction 11) The oath or declaration is objected to by the Examine 11.	epted or b) objected to by the did drawing(s) be held in abeyance. Section is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).
Priority under 35 U.S.C. § 119		
 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the prior application from the International Bureau * See the attached detailed Office action for a list 	s have been received. s have been received in Applicati ity documents have been receive ı (PCT Rule 17.2(a)).	on No ed in this National Stage
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)		
Paper No(s)/Mail Date 7-10-03.	6) 🔲 Other:	

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

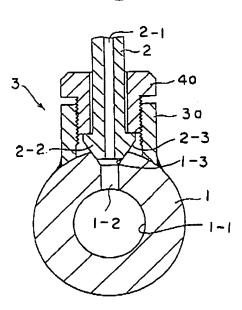
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,979,945 to Hitachi et al.. The Hitachi et al. illustrates all the structural features of the claimed invention. Applicant's claims are considered product-by-process claims wherein the improvement features all depend on how the pipe rail is manufactured. It has been found that a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In

Art Unit: 3679

an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. <u>In re Hirao et al.</u>, 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

Fig. 1



Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for Technology Center 3600 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <a href="http://pair-

Application/Control Number: 10/616,571 Page 5

Art Unit: 3679

<u>direct.uspto.gov</u>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

ekn 12/7/04

Eric K. Nicholson
Primary Examiner
Technology Center 3600

a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Kluq, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).